

ESTTA Tracking number: **ESTTA686522**Filing date: **07/29/2015**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	DRILLTEC PATENTS & TECHNOLOGIES CORPORATION
Granted to Date of previous extension	07/29/2015
Address	10875 KEMPWOOD DRIVE, SUITE 2 HOUSTON, TX 77043 UNITED STATES
Attorney information	Thad J. Faleski Conley Rose, P.C. P.O. Box 3267 HOUSTON, TX 77253-3267 UNITED STATES tmhou@conleyrose.com

Applicant Information

Application No	79155916	Publication date	03/31/2015
Opposition Filing Date	07/29/2015	Opposition Period Ends	07/29/2015
International Registration No.	1225099	International Registration Date	08/26/2014
Applicant	Walter Stauffenberg GmbH & Co. KG Im Ehrenfeld 4 GERMANY		

Goods/Services Affected by Opposition


Class 006. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Pipe clamps primarily comprised of metal
Class 020. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Pipe clamps of plastic

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2365114	Application Date	05/11/1998
Registration Date	07/04/2000	Foreign Priority	NONE

		Date	
Word Mark	ACT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 006. First use: First Use: 1999/04/28 First Use In Commerce: 1999/04/28 PROTECTORS OR COVERS IN USE WITH METAL PIPES OR TUBES TO PROTECT THE THREADS OF THE PIPES OR TUBES		

Attachments	75482786#TMSN.png(bytes) Signed Notice of Opposition.pdf(278559 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Thaddeus J. Faleski/
Name	Thad J. Faleski
Date	07/29/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re U.S. Trademark Application Serial No. 79/155,916 for the mark ACT, filed on August 26, 2014, published on March 31, 2015, and having the current owner of record Walter Stauffenberg GmbH & Co. KG

Drilltec Patents & Technologies
Corporation

Opposer,

vs.

Walter Stauffenberg GmbH & Co. KG,

Applicant.

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Opposition No. _____

NOTICE OF OPPOSITION

Commissioner:

Drilltec Patents & Technologies Corporation (hereafter, the “Opposer”), a corporation organized under the laws of the state of Delaware having a principal place of business at 10875 Kempwood Drive, Suite 2, Houston, Texas 77043, United States, believes that it will be damaged by Walter Stauffenberg GmbH & Co. KG’s (hereafter, the “Applicant”) registration of the mark ACT in International Classes 006 and 020 as shown in U.S. Trademark Application Serial No. 79/155,916. Accordingly, Opposer hereby opposes the same under the provisions of the Trademark Act of 1946, § 1063 of Title 15 of the United States Code.

Opposer alleges the following as standing to oppose the application and as grounds for the opposition:

1. For over three decades, Opposer has been a world leader in innovating, engineering, manufacturing, and selling critical pipe-protection products that protect the threads of metal pipes and metal tubular goods against damage caused by corrosion and physical impact, such as might occur during storage, transport, and handling if left unprotected (such products sometimes referred to herein as “thread protectors”).

2. Opposer is the owner of, and long ago developed rights with respect to certain trademarks that are used in connection with its sale of thread protectors for metal pipes and tubular goods, including the mark ACT, which is registered under U.S. Trademark Registration No. 2,365,114 in International Class 006 for use in connection with “protectors or covers in use with metal pipes or tubes to protect the threads of the pipes or tubes” (hereafter, the “’114 Registration”). The ‘114 Registration issued to Opposer on July 4, 2000.

3. Opposer’s use of the word mark ACT in connection with the goods identified in the ‘114 Registration, including its thread protectors for metal pipes and tubulars, began at least as early as April 1999, and such use has been extensive, continuous and continues to date. Pursuant to 15 U.S.C. §1065, the right to use the ACT mark of the ‘114 Registration in commerce on or in connection with its recited pipe-related products is incontestable.

4. Opposer’s ACT mark has been extensively used and promoted, and Opposer continues to use and promote its ACT mark in connection with the goods identified in the ‘114 Registration, including thread protectors for metal pipes. Considerable effort and expense has been expended in promoting Opposer’s ACT mark and the pipe-related products offered and sold in connection therewith. As a result, substantial rights have been developed in Opposer’s ACT

mark, which have acquired great value as an identification of its pipe-related products offered thereunder. Through the advertising, marketing, and sale of its products under the ACT mark, Opposer has built up and thereby acquired valuable and significant goodwill symbolized by its ACT mark.

5. By virtue of Opposer's extensive advertising, marketing, sales, and quality control over the years, the ACT trademark has become well known and famous and an indication of high-quality, pipe-related products that emanate from a single source.

6. The ACT trademark has become an important asset of substantial value as a symbol of Opposer's identity and its longstanding business activities. As such, the relevant consumers and purchasers have come to know the ACT trademark as an indicator of thread protectors for metal pipes and tubulars that originate from Opposer.

7. The goodwill embodied in the ACT trademark, and consequently Opposer's valuable reputation and credibility in the oil and gas industry, and in particular the Oil Country Tubular Goods (OCTG) industry, and among its other consumers, depends on the integrity of the ACT trademark as an identification used exclusively by Opposer, and not of any other source.

8. On August 26, 2014, Applicant filed U.S. Trademark Application Serial No. 79/155,916 for the word mark ACT under §66(a), 15 U.S.C. §1141f(a) based on Applicant's intent-to-use the mark on or in connection with "pipe clamps primarily comprised of metal" in International Class 006 and "pipe clamps of plastic" in International Class 020 (hereafter, the "Opposed Application").

9. The Opposed Application published on March 31, 2015. The U.S. Trademark Trial and Appeal Board granted Opposer extensions of time to file this opposition through July 29, 2015.

10. Pursuant to the U.S. Trademark Office records, the current owner of the Opposed Application is Walter Stauffenberg GmbH & Co. KG, Im Ehrenfeld 4, 58791 Werdohl, GERMANY.

11. As noted above, Opposer's use of the incontestable ACT mark began at least as early as April 28, 1999 in interstate commerce on or in connection with the pipe-related goods identified in the '114 Registration, and such use has been continuous and continues to date. In addition, the application filing date of the incontestable ACT mark of the '114 Registration is May 11, 1998, more than a decade and a half before the August 26, 2014 filing date of the Opposed Application. Accordingly, Opposer's rights with respect to the incontestable ACT mark of the '114 Registration predates any rights Applicant can claim to the ACT mark represented by the Opposed Application, and thus, Opposer's ACT trademark has priority over Applicant's use of the word mark ACT as a product identifier.

12. Applicant's word mark ACT as represented by the Opposed Application is identical to Opposer's ACT trademark as represented by the '114 Registration.

13. Applicant's goods identified in the Opposed Application are closely related and similar to the goods identified in the '114 Registration. For example, Applicant's identified in the Opposed Application and Opposer's goods identified in the '114 Registration both relate to pipes and tubular goods.

14. The goods identified in the Opposed Application would be sold in the same channels of trade and to the same class of purchasers as the goods recited in the '114 Registration.

15. At least due to the Applicant's word mark ACT being identical to Opposer's ACT trademark, the similarity of the goods identified in the Opposed Application and the '114

Registration, and the similarities in channels of trade and class of purchasers of the goods identified in the Opposed Application and the '114 Registration, customers and prospective customers of Applicant's goods are likely to be confused, mistaken or deceived into the belief, contrary to fact, that Applicant's goods, to be sold under the mark of the Opposed Application, emanate from or are in some way endorsed, approved or sponsored by Opposer or that Applicant or its products are affiliated with Opposer in some way.

16. As a result of the similarity between Opposer's ACT trademark and Applicant's ACT mark, the degree of recognition of the Opposer's ACT trademark, and the length and substantially exclusive nature of Opposer's use in commerce of the ACT trademark, registration of Applicant's ACT mark is likely to cause dilution of Opposer's famous ACT trademark.

17. Pursuant to the allegations stated above, registration of Applicant's ACT mark shown in the Opposed Application will result in damage to Opposer under the provisions of § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d) and § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

WHEREFORE, Opposer prays that registration of the mark shown in U.S. Trademark Application Serial No. 79/155,916 be refused and that this Notice of Opposition be sustained in favor of Opposer.

Authorization is hereby granted to the U.S. Patent and Trademark Office to deduct the filing fee for the present opposition in the amount of \$600.00 (for both classes of the opposed application) from Conley Rose Deposit Account No. 501515. Should any additional fees be due, please also charge them to Deposit Account No. 501515.

Respectfully submitted,

Dated: July 29, 2015

By: 

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ATTORNEYS FOR OPPOSER

CERTIFICATE OF TRANSMISSION UNDER TBMP 110

I HEREBY CERTIFY that a true and correct copy of this document, *Notice of Opposition*, opposing registration of U.S. Trademark Application Serial No. 79/155,916 for the mark ACT, is being filed electronically through <http://esta.uspto.gov> via the Trademark Trial and Appeal Board Electronic Filing System.

On the 29th day of July, 2015.


Melissa Kirchhoff

CERTIFICATE OF SERVICE UNDER TBMP 113

I HEREBY CERTIFY that a true and correct copy of the foregoing *Notice of Opposition*, opposing registration of U.S. Trademark Application Serial No. 79/155,916 for the mark ACT, is being sent by First Class U.S. Mail, postage prepaid, to counsel for Applicant, Walter Stauffenberg GmbH & Co. KG, as follows:

Charles F. Reidelbach, Jr.
Higgs Fletcher & Mack LLP
401 West A Street, Suite 2600
San Diego, California 92101
United States

On the 29th day of July, 2015.


Melissa Kirchhoff